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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/577,790      | 05/24/2000  | Antonio Moroni       | 498-206             | 4530             |

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| EXAMINER |
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PELLEGRINO, BRIAN E

|          |              |
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| ART UNIT | PAPER NUMBER |
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3738

DATE MAILED: 08/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/577,790

Applicant(s)

MORONI, ANTONIO

Examiner

Brian E Pellegrino

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3738

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of Species I in Paper No. 6 is acknowledged. The traversal is on the ground(s) that there should not be a restriction. It should be noted that the restriction was not for different inventions, but **SPECIES**, differentiating the various uses of the fabric and also the different patterns of weaving. If applicant wishes to traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species and subspecies to be obvious variants or clearly admit on the record that this is the case. Applicant's traversal is not found persuasive because applicant has not submitted evidence or identified evidence of record showing the species to be obvious variants or clearly admit on the record that this is the case, the requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 6, 8, 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kudo et al. (4331697). Kudo et al. disclose the use of a biomaterial for tubular devices such as vascular prostheses and shunts, col. 1, lines 24-30, col. 5, lines

Art Unit: 3738

38-46. Kudo discloses the material can be polyethylene naphthalate, col. 7, lines 51-55. Regarding claim 8, Kudo additionally discloses the use of a coating by placing a heparin derivative on the surface of the implant, col. 10, lines 1-3. Coatings adhere to porous surfaces and since the substrate material supports a coating, it can be construed that the material is a "fabric," since fabrics are porous. The examiner asserts that the claimed physical properties (in this case, the material being radiation resistant and hydrolytically stable) are present in the Kudo et al. material to some extent even though they are not explicitly recited. Therefore, the examiner hereby burdens the applicant to show that these properties are not present in the prior art. Since there is no objective or quantitative measurements as to ascertain what is considered "radiation resistant" or "hydrolytically stable" the properties are inherently possessed by the prior art material.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4, 9, 10, 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo et al. in view of Schmitt (5443499). Kudo et al. is explained supra. However, Kudo does not disclose the construction of the polymer or the number of filaments used and the denier of the material with a stent. Schmitt teaches a braided tubular prosthesis for use in blood vessels, col. 2, lines 5, 6, 15-20. Schmitt also teaches a prosthesis that has 115 denier and 100 filaments that are partially oriented to be used for as graft material and can be attached with a stent, col. 7, lines 31-40. It would have been obvious to one of ordinary skill in the art to use the construction and

application of graft material with a stent fixation device as taught by Schmitt for the graft of Kudo in order to effectively repair a collapsed blood vessel by using the combination stent-graft.

Claims 4, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo et al. '697 in view of Barone et al. (EP 461791). Kudo is explained supra. However, Kudo et al. do not disclose the graft construction or use with a stent. Barone et al. teach graft materials for use in vascular bodies can be of woven construction, col. 8, lines 18-25. Barone also teaches the graft is to be used with a support structure in the form of a stent, col. 9, lines 4-28 and Figs. 4, 6. It would have been obvious to one of ordinary skill in the art to use the construction and application of graft material with a support structure as taught by Barone et al. for the graft of Kudo in order to effectively repair a collapsed blood vessel by using the combination stent-graft.

Claim 18 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kudo et al. '697. Kudo is explained supra. However, Kudo does not explicitly recite how the entire process of obtaining the product is performed. Kudo discloses shaping the polymer, col. 8, lines 64-68. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986), see MPEP 2112.02.

### ***Response to Arguments***

Applicant's arguments filed 4/18/02 have been fully considered but they are not persuasive. The claiming of a new use, new function or *unknown property* which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Where applicant claims a composition in terms of a function, *property or characteristic* and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under 35 U.S.C. 102, see MPEP 2112.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Art Unit: 3738

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian E. Pellegrino  
July 30, 2002  
TC 3700, AU 3738

  
Paul Prebilic  
Primary Examiner